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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,984	03/06/2002	Min Ming Tarng		6341

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02/10/2004

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San Jose, CA 95129

EXAMINER

CHAMBERS, MICHAEL S

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 02/10/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,984

Applicant(s)

TARNG ET AL.

Examiner

Michael Chambers

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

Specification

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph.

A substitute specification which includes the claims is required pursuant to 37 CFR 1.125(a) because the specification appears to be a literal translation of a foreign text. The specification appears to be a narrative explanation of the invention and provides no useable information as to the metes and bounds of the invention or how it is used. The substitute specification should be proof read prior to submission to insure an accurate and correct document is submitted. Some examples of the terms and sentence fragments are noted below:

Page 1: Golh sports are the century sports for the 21st century.

Page 1: Golh is the golf hybrid of disk and ball.

Page 1: As shown in fig 1, the disk in golh sport is referred to be golffrisbee.

Page 1: The ball in golh sport is referred to be golfball.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a

marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Note: The substitute specification that was filed on 11/3/03 was not entered in the file. The reason for the non-entry is that inclusion of new matter in the specification and the drawings. New matter is not permitted to be added to an existing application. If the applicant wishes to continue prosecution of this application, they may wish to consider filing a Continuation-in-Part application. This type of application permits the inclusion of new matter prior to submitting the application. If the applicant chooses to file a CIP, they would not be required to file a marked up copy of the specification as the new specification could contain any new matter the applicant wished to include prior to filing the application. But it is strongly suggested that the specification be proof read by a party familiar with sentence structure. The PTO while willing to help pro se's in the patenting process cannot be a proof reader for the applicant. It is the examiner 's belief that if the proposed specification and drawings are adequately proof read and the application is filed as a CIP, the 112 1st paragraph rejections will be removed.

If the applicant chooses to continue with this application, a substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter and the specification should not contain any new matter in the written portion or the drawing portion.

Since the specification has not been entered, this office action relates back to the original specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71 (a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the application fails to adequately teach how to make and/or use the invention. Although the application calls for a flying disk type game, it does not clearly disclose how to make and use the invention. The apparatus should be disclosed in a clear and concise way which would permit one skilled in the art to make the instant invention without undue experimentation. The application broadly describes the invention but not in a clear and concise manner. It is not clear from the specification what the invention is or what the metes and bounds of the invention are. The specification reads as a narrative account of various games and devices that may be used but fails to clearly define the invention or how to make and use the device.

In addition, objection is made to the drawings as not being in compliance with 37CFR 1.83 and 1.84 and MPEP 608.02 making the disclosure difficult to understand. It is unclear to the examiner the purpose of function of the device and how it operates. For

example the specification notes that a motor is optional but does not clearly explain its purpose of how it functions (page 15, paragraph 3).

Claims 21 - 40 are rejected under 35 USC, 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not apparent from the specification what the described structure is, how it is manufactured ,how it functions or what each part is intended to do. See comments made above in the preceding paragraph.

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms “bi-directional airfoil”, “uni-directional wing”, have not been explained adequately in the specification to permit one of ordinary skill in the art to know the metes and bounds of the invention.

As to claims 21 -26: They inherit the deficiencies of claim 21.

Claims 27-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. One of ordinary skill in the art would not be able to determine the metes and bounds of the invention.

As to claim 27: The terms “pole means”, “flying means” and fitting means are vague and indefinite.

As to claims 28 -38: They inherit the deficiencies of claim 27.

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 39 is a dependent claim that depends from claim 38. This is an indefinite claim.

As to claim 40: The terms "pole means", "flying means" and fitting means are vague and indefinite.

Regarding the claims 21-40, the word "means" is preceded by the word(s) "golfrisbee, golh club, head, cavity, skirt, small stub in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ e94 (Bd. App. 1967).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

The examiner appreciates the time and effort by the applicant to bring the specification and claims into compliance. The specification as presented should be adequate once it is proof read to remove sentence fragments and other grammatical problems. The reason for suggesting the filing of the CIP application is to permit the drawings and new specification to be entered in an easy fashion in lieu of new matter rejections of the existing specification.

The applicant should also include the following paragraph at the beginning of the specification. This will insure the application receives expedited handling.

This is a Continuation in Part application claims priority of U.S. patent application Ser. No. 10/091984, filed March 06, 2002, now abandoned, which herein incorporated by reference in its entirety.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chambers whose telephone number is 703-306-5516. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Michael Chambers
Examiner
Art Unit 3711

January 26, 2004


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700